

In re Serial No. 08/485,129

REMARKS

Claims 11-14 and 34-45 presently appear in this case. Claims 14, 39, 42 and 45 have been withdrawn from consideration. No claims have been allowed. The Advisory Action of December 2, 1997, has now been carefully studied. Reconsideration and withdrawal of at least some of the present rejections is hereby respectfully urged.

Briefly, the present invention relates to isolated DNA molecules which encode naturally occurring TBP-II. TBP-II is a novel tumor necrosis factor binding protein which is an extracellular domain of a TNF receptor. It was first disclosed in the parent applications of the parent application, and one claim directed to this protein was officially found to be allowable by the examiner in charge of the present case. The claims drawn to the protein in parent application no. 07/930,443 are now involved in an interference proceeding with the claims of USP 5,344,915. The present application claims any isolated DNA molecule encoding the novel TBP-II protein, as well as replicable expression vehicles capable of expressing that protein, host cells transformed with such replicable expression vehicles and processes for producing the protein by culturing such host cells.

On November 3, 1997, applicant filed an amendment and detailed arguments as to the allowability of the present application. On December 2, 1997, the examiner issued an Advisory Action with a detailed explanation as to why the

rejections would be maintained. Upon review of this Advisory Action it became apparent to applicant that some of the rejections could be overcome with relatively minor changes to the claims. The present amendments make these relatively minor changes to claims 11, 35 and 36 in the hopes of overcoming certain of the examiner's rejections and thus limiting the issues for the purpose of appeal.

In the Advisory Action of December 2, 1997, the examiner rejected claims 35 and 36 under 35 USC 112, first paragraph, on the ground that there is no support in the specification as filed for the DNA of these claims. The examiner specifically objected to the N-terminal sequence recited in claims 35 and 36 where Xaa consists of Ala-Gln-Val-Ala-Phe-Thr. Further, the examiner stated that there is no disclosure in foreign priority document Israel 90,339 of the N-terminal amino acid sequence recited in claims 35 and 36 where Xaa consists of Ala-Gln-Val-Ala-Phe-Thr.

In order to overcome this part of the rejection and to establish that claims 35 and 36 are entitled to the effective filing date of foreign priority document Israel 90,339, the recitation of Xaa being Ala-Gln-Val-Ala-Phe-Thr has now been deleted from these claims. It is not believed that the deletion of this embodiment from claims 35 and 36 would require any further consideration or search by the examiner as the examiner has already presumably searched all the species of claims 35 and 36. As this amendment should obviate the rejection of paragraph

6 of the Advisory Action, it is urged that this amendment be entered and that the examiner acknowledge that this rejection has now been obviated.

Applicant has no further comments at this time relating to the section 7 beginning at page 2 of the Advisory Action as these issues will be discussed in detail in the appeal brief. However, with respect to the section 7 beginning at page 7 of the Advisory Action, it is believed that this rejection has been obviated by the present amendment.

In this section of the Advisory Action, the examiner maintained the rejection under 35 USC 102(e) of all of the claims under examination as being anticipated by Smith. The examiner states that there is no disclosure of the scope of claim 11 in foreign priority document Israel 90,339 insofar as this claim recites "and/or to maintain the prolonged beneficial effects of TNF".

By the present amendment, claim 11 has been amended to delete the recitation "and/or to maintain the prolonged beneficial effects of TNF". Thus, the property of the protein still recited in claim 11 is that it has "the ability to inhibit the cytotoxic effect of TNF". This property is fully supported in the foreign priority document Israel 90,339. The deletion from claim 11 of the newly discovered property of being able to maintain the prolonged beneficial effects of TNF does not create new matter or any new issue. For example, this property never did appear in claims 35 and 36. Furthermore, it is proposed to

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amend claim 11 to specify that the ability to inhibit the cytotoxic effect of TNF is that ability to inhibit "the cytotoxic effect of TNF- α on murine A9 cells". This amendment is being made only to provide in claim 11 a certain amount of parallel language structure to that which appears in claims 35 and 36. As this language has not been objected to in claims 35 and 36, it should not be objectionable in claim 11 and therefore no new issues are raised.

As the only portion of claim 11, which the examiner stated did not find support in the Israel priority document 90,339 has now been deleted from claim 11, it is believed that claim 11 is now fully supported by the 90,339 priority document, thereby antedating Smith. Accordingly, it is believed that the rejection of claim 11 and those claims dependent therefrom has been overcome and should be removed for the purpose of appeal.

The examiner also stated that claims 35 and 36 were not entitled to the effective filing date of foreign priority document Israel 90,339 because there is no disclosure of the N-terminal amino acid sequence wherein Xaa consists of Ala-Gln-Val-Ala-Phe-Thr in that application. However, as discussed above, claims 35 and 36 have now been amended to delete this particular recitation, thus obviating this issue. The remaining language of claims 35 and 36 is fully supported in the Smith application. Accordingly, claims 35 and 36 and those claims dependent therefrom are now fully supported by the Israel 90,339 application, thereby antedating Smith. Reconsideration and

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withdrawal of the rejection of the claims under 35 USC 102(e) as being anticipated by Smith is respectfully urged.

If the present amendment is entered and the examiner agrees that the 35 USC 112 rejection of claims 35 and 36 as appearing at section 6 on page 2 of the Advisory Action and the anticipation rejection over Smith as appearing in section 7 at page 7 of the Advisory Action will be overcome, only the 35 USC 112, first paragraph, issue as it relates to all of the claims commencing at the bottom of page 2 of the Advisory Action, will be left of record for the purpose of appeal. Prompt consideration of this supplemental amendment and acknowledgment that it may be entered for the purpose of appeal and that it obviates the two rejections discussed above are earnestly solicited.

Respectfully submitted,

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